



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Elazar Rabbani et al.

Serial No. 09/439,594

Group Art Unit: 1635

Filed: November 12, 1999

Examiner: Joyce Tung

Title: DETECTING THE PRESENCE OF SPECIFIC TARGET NUCLEIC ACID SEQUENCES
THROUGH STEM-LOOP FORMATION

**TRANSMITTAL
THIRD INFORMATION DISCLOSURE STATEMENT**

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

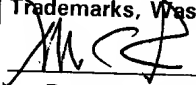
Sir:

Transmitted herewith is a Third Information Disclosure Statement which is being filed in accordance with 37 C.F.R. §§ 1.56 and 1.97-1.98. The items listed on Form PTO-1449, a copy of which is enclosed, may be deemed to be pertinent to the above-identified application and are made of record to assist the Patent and Trademark Office in its examination of this application. The Examiner is respectfully requested to fully consider the items and to independently ascertain their teaching.

1. [] For each of the following items listed on the enclosed copy of Form PTO-1449 that is not in the English language, an English language translation of that item or a portion thereof or a concise explanation of the relevance of that item is enclosed:

04/03/2003 MAHRED1 00000130 051135 09439594

01 FC:1806 180.00 CH

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No. EV160376595US	
Deposit Date	March 27, 2003
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231.	
 Ronald C. Fedus Reg. No. 32,567	MAH 27 2003 Date

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Page 2 [Third Information Disclosure Statement -- March 27, 2003]

2. ☐ For each of the following items listed on the enclosed copy of form PTO-1449 that is not in the English language, a concise explanation of the relevance of that item is incorporated in the specification of the above-identified application.
3. ☐ Any copy of the items on the enclosed copy of Form PTO-1449 that is not enclosed with this Information Disclosure Statement was previously cited by or submitted to the Patent and Trademark Office in the prior ☐ Divisional or ☐ Continuation-In-Part application under 37 C.F.R. §1.60, U.S. Serial No. _____, filed _____.
4. ☐ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with:
- ☐ 37 C.F.R. §1.97(b)(1), within three months of the filing date of the above-identified application.
- ☐ 37 C.F.R. §1.97(b)(2), within three months of the date of entry into the national stage as set forth in §1.491 in an international application.
- ☐ 37 C.F.R. §1.97(b)(3), before the mailing date of a first Office action on the merits.
5. ☐ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action), and is accompanied by one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below.
6. ☒ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a notice of allowance (where there has been no prior final action):
- ☐ A check in the amount of \$240.00 is enclosed in payment of the fee.
- ☒ Charge the fee to Deposit Account No. 05-1135, Order No. ENZ-58.
A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

7. ☐ A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(d), after the mailing date of a final action or a notice of allowance, whichever comes first, but before payment of the issue fee, and is accompanied by:

- a. one of the certification pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below; and
- b. the attached petition requesting consideration of this Information Disclosure Statement; and
- c. the fee due under 37 C.F.R. §1.17(i)(1) which is paid as set forth in paragraph 10 below.

8. ☐ A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in compliance with:

- a. ☐ 37 C.F.R. §1.313(b)(3), after the issue fee has been paid and information cited in this Information Disclosure Statement may render at least one claim unpatentable and is accompanied by the attached Petition To Withdraw Application From Issue;
- b. ☐ 37 C.F.R. §1.313(b)(5), after the issue fee has been paid and information cited in this Information Disclosure Statement is to be considered in a Continuation application upon abandonment of the instant application and is accompanied by the attached Petition To Withdraw Application From Issue.
- c. ☐ The fee due under 37 C.F.R. §1.17(i)(1) is paid as set forth in paragraph 10 below.

9. ☐ I hereby certify that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.

☐ I hereby certify that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

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Serial No.: 09/439,594
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Page 4 [Third Information Disclosure Statement -- March 27, 2003]

10. ☐ A check in the amount of \$130.00 is enclosed in payment of the fee due under 37 C.F.R. §1.17(i)(1).

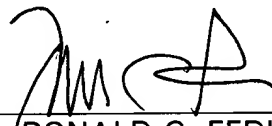
☐ Charge the fee under 37 C.F.R. §1.17(i)(1) to Deposit Account No. 05-1135. Order No. _____. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

☒ The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 05-1135. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,

Dated: March 27, 2003

By:



RONALD C. FEDUS

Registration No. 32,567

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Mailing Address:

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292 Madison Avenue, 9th Floor
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Elazar Rabbani et al.

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527 Madison Avenue, 9th Floor
New York, New York 10022
March 27, 2003

FILED BY EXPRESS MAIL

Commissioner for Patents
Washington, D.C. 20231

**THIRD INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. §§1.56 & 1.97-1.98**

Dear Sirs:

Pursuant to the provisions of 37 C.F.R. §§1.97-1.98, and in full compliance with their duty of disclosure under 37 C.F.R. §1.56, Applicants, through their attorney, are bringing the following three (3) documents to the attention of the U.S. Patent and Trademark Office and the Examiner handling their above-identified application:

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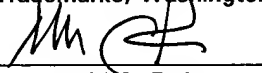
Elazar Rabbani et al.

Serial No. 09/439,594

Filed: November 12, 1999

Page 2 (Third Information Disclosure Statement Under 37 C.F.R.

§§ 1.56 & 1.97-1.98 – March 27, 2003)

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No.	EV160376595US
Deposit Date	March 27, 2003
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231.	
	MAK 27 2003
Ronald C. Fedus Reg. No. 32,567	Date

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Serial No. 09/439,594

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Page 3 (Third Information Disclosure Statement Under 37 C.F.R.

§§1.56 & 1.97-1.98 – March 27, 2003)

1. Whitcombe D.M. et al., U.S. Patent No. 6,326,145B1 issued December 4, 2001 [Exhibit 1];
2. Gibson, N.J. et al., U.K. Patent No. GB 2,338,301B issued August 2, 2000 [Exhibit 2]; and
3. Witcombe, D. et al., "Detection of PCR products using self-probing amplicons and fluorescence," Nature Biotechnology 17:804-807 (1999). [Exhibit 3].

Applicants' attorney became aware of the last two above-listed documents, (Exhibits 2 and 3) last month. The first above-listed document (Exhibit 1), came to the undersigned attorney's attention through a subsequent search of the United States Patent and Trademark Office database.

A completed Form PTO-1449 listing the 3 above-submitted documents is also attached hereto as Exhibit 4.

By this voluntary citation of art, Applicants and their attorney are requesting that the documents be made of record in the present application.

The above citation of documents is not a representation that these documents constitute a complete or exhaustive listing, nor that the above listing necessarily includes the closest or most relevant documents, nor are these documents necessarily a complete listing of all documents known to Applicants or their attorney. It is simply a voluntary citation of documents made in good faith, which is not intended to serve in any way as a substitute for the Examiner's own search.

In view of the general and specific features described and claimed in the present application, Applicants respectfully submit that the present invention is neither disclosed nor suggested by the documents referred to above and is thus patentably distinct thereover. Furthermore, Applicants do not believe, and do not submit, by the citation of these references, that these documents, either by

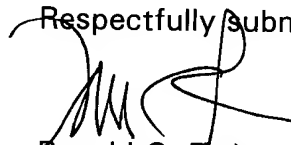
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§ 1.56 & 1.97-I.98 – March 27, 2003)

themselves or in combination with other documents, render the invention *prima facie* obvious under the duty of disclosure rules.

Applicants respectfully request that the Examiner make the above-submitted documents of record in the instant application. Applicants further request that the Examiner consider these documents as any of them may relate to the instant application.

The fee under 37 C.F.R. § 1.17(p) for filing this Information Disclosure Statement is \$180.00. The Patent and Trademark Office is hereby authorized to charge the amount of this fee (and any other fees in connection with this IDS) to Deposit Account No. 05-1135, or to credit any overpayment thereto.

Respectfully submitted,



Ronald C. Fedus
Registration No. 32,567
Attorney for Applicants

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Form PTO-1449 U.S. Department of Commerce

(REV. 8-83) Patent and Trademark Office

Atty. Docket No.
Enz-58(D1)

Serial No. 09/439,594

**EXAMINER'S
COPY**

INFORMATION DISCLOSURE CITATION

(use several sheets if necessary)

Applicants: Elazar Rabbani et al.

Filed: Nov. 12, 1999

Group: 1635

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPRO- PRIATE
	6 3 1 6 1 4 5 B 1	12/04/01	Whitcombe D.M. et al.			

FOREIGN PATENT DOCUMENTS

DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	TRAN- SLATION YES NO
GB 2 3 3 8 3 0 2B	08/02/00				

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

Whitcombe, D. et al., Nature Biotechnology 17:804-807 (1999)**RECEIVED**

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EXAMINER

DATE CONSIDERED

*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.